



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,475	03/01/2004	John M. Krochta	023070-141800US	2113

20350 7590 09/04/2007
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

PADEN, CAROLYN A

ART UNIT	PAPER NUMBER
----------	--------------

1761

MAIL DATE	DELIVERY MODE
-----------	---------------

09/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/791,475	Applicant(s) KROCHTA ET AL.	
	Examiner Carolyn A. Paden	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 16-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 16-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The terminal disclaimer has been entered into the application.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 16-64 are rejected under 35 U.S.C. 103(a) as being obvious over Krochta (6,869,628) for reasons of record.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference

are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Applicants' statements have been considered but do not overcome the rejection because the statement must specify common ownership "at the time of applicants' invention".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by McCabe (6,830,766) for reasons of record used in rejecting claims 1-10, 14-22, 25, 28-39, 43-49 and 51-54).

Applicant argues that McCabe uses glycerin as a plasticizer. This has been considered but is not persuasive. The claims call for a polyhydric alcohol as a plasticizer. McCabe uses maltitol in his coating. The fact that McCabe may use a different plasticizer does not alter the fact that the ingredients of the claims are fully disclosed by McCabe. Applicants arguments relating to the extent of gloss in the product does not overcome the rejection because the gloss appears to be an optional feature in the claims.

Claims 1-9, 16, 17, 20,, 21, 22, 24-31, 35-37, 39-44, 47-49 and 51-54 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe (6,830,766) for reasons of record.

Applicant argues that McCabe uses glycerin as a plasticizer. This has been considered but is not persuasive. The claims call for a polyhydric alcohol as a plasticizer. McCabe uses maltitol in his coating. The fact that McCabe may use a different plasticizer does not alter the fact that the ingredients of the claims are fully disclosed by McCabe. Applicants'

arguments relating to the extent of gloss in the product does not overcome the rejection because the gloss appears to be an optional feature in the claims.

Applicant argues that McCabe is not glossy. This has been considered but is not persuasive. McCabe also adds lipid to his coating. Upon comparing the claimed product with McCabe, one of ordinary skill in the art would expect the McCabe coating to have gloss because it contains the same ingredients as those in the claims. Applicant argues that one would not expect to coat nuts with the coating of the claims. The rejection claims do not contain nuts.

Claims 1-9, 16-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Best (2005/0118311).

Best discloses reduced fat flavored coating made from a combination of sugar and hydrocolloid. The hydrocolloid may include protein as a selected hydrocolloid (paragraph 008). The sugar may include disaccharide, sucrose or a polyhydric alcohol (paragraph 009). In examples 9 and 10, cocoa is included and the cocoa is regarded to be the source of cocoa butter in the product. Contrary to applicants arguments, the product is disclosed as providing a glossy coating at the end of

paragraph 008. The claims appear to differ from Best in the recitation of an example in the reference of a coating that contains the specific protein ingredients of the claims. But where Best teaches that both whey protein isolate and soy protein isolate are hydrocolloid ingredients useful for preparing a glossy coating, it would have been obvious to select these ingredients for coating composition when albumin is not available. No unobvious difference is seen between the gloss in Best and the high gloss of the claims. The extent of gloss in a product is seen to be a subjective evaluation that is not alone seen to constitute unobviousness. It is appreciated that WPC is not mentioned but no unobvious or unexpected result is seen from the selection of WPC and whey protein isolate because they both are formed from whey proteins.

The rejection of the claims over Cook (5,705,207) has been withdrawn for the reasons argued by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on (571) 272-1401 or by dialing 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Carolyn Paden
CAROLYN PADEN
PRIMARY EXAMINER
GROUP 1800
8-29-07
1761